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10/799,865	03/11/2004	Harold D. Beck	03-36	1719

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EXAMINER
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RONESI, VICKEY M

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/799,865

Applicant(s)

BECK, HAROLD D.

Examiner

Vickey Ronesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 12-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-38 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/11/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-11, drawn to a composition, classified in class 524, subclass 564.
  - II. Claims 12-35, drawn to an automotive component, classified in class 428, subclass 428/36.9.

2. The inventions are distinct, each from the other because:

Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as non-automotive articles such as chewing gum or an adhesive and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. It is noted that while claims 26-35 are drawn to a method of using the composition, the claims have been combined with the article claims (claims 12-25 and 36-38) given that no significant method steps are presented to distinguish the method from the article.

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. During a telephone conversation with Joseph Tassone on 6/10/2005 a provisional election was made WITHOUT traverse to prosecute the invention of Group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-35 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### *Specification*

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: there is no support for the range 25 to 75% recited in claim 8.

7. The disclosure is objected to for the following reasons:

- Throughout the specification, an inconsistent description of the relative amounts of ingredients is observed. For example, on page 8, none of the percentages corresponding to the amounts of the ingredient indicate the basis but then on page 9 most of the ingredients are indicated in "% by weight." Please review the entire specification and indicate the basis for all percentage amounts. In amending the specification, no new matter should be introduced.

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- Both the copolymer containing two vinyl esters and the copolymer containing vinyl acetate and ethylene are incompletely described since no basis is given for the relative amounts of comonomer, i.e., is it wt % or mole %?

Appropriate correction is required.

### *Claim Objections*

8. Claims 4, 9, 10, and 11 are objected to for the following informalities:

With respect to claim 4, "said elastomer composition" lacks antecedent basis and should read as "the elastomeric composition" as recited in line 1 of claim 1.

With respect to claim 9, the word "copolymer" should be inserted after "ethylene-vinyl acetate" in line 3 of the claim to indicate that it is a polymer.

With respect to claims 10 and 11, the term "by weight" should be inserted before the ingredients "1-octanedecanamine" and "organic phosphate ester." Moreover, the word "and" should be inserted before the last component to complete the claim language.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 5, 7, 10, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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With respect to claims 5, 10, and 11, the relative amounts of vinyl acetate and vinyl laurate in the copolymer lacks basis, i.e., is it based on weight % or mole %? There is no support in the specification for the basis. In amending claims, new matter should not be introduced. The specification is deficient on similar grounds.

With respect to claims 7 and 11, the relative amounts of vinyl acetate and ethylene in the copolymer lacks basis, i.e., is it based on weight % or mole %? There is no support in the specification for the basis. In amending claims, new matter should not be introduced. The specification is deficient on similar grounds.

With respect to claim 8, the amount of additives lacks basis, i.e., is it based on weight % or volume %? In amendment the claim, new matter should not be introduced.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Hartman et al (US 5,173,317).

Note that the preamble “heat tolerant, pressure resistant elastomeric composition exhibiting improved hydrocarbon fluid impermeability” and “useful in the manufacture of automotive hoses, belts, seals, dampers and engine mounts which require resistance to heat, pressure and hydrocarbon fluids” has not been given patentable weight. Case law holds that

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“where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation.” See *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997).

Hartman et al discloses a chewing gum composition comprising a 10-45 wt % vinyl laurate/vinyl acetate copolymer containing 10-45 wt % of vinyl laurate (col. 2, lines 23-47); polyisobutylene (col. 2, lines 48-50); and other additives such as plasticizers (col. 2, lines 57 to col. 3, line 6) and fillers, texturizers, colorants, and antioxidants (col. 4, lines 5-38). See Table 1 in Col. 4 for exemplified amounts of ingredients.

In light of the above, it is clear that Hartman et al anticipates the presently cited claims.

11. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by D’Amelia et al (US 4,968,511).

Note that the preamble “heat tolerant, pressure resistant elastomeric composition exhibiting improved hydrocarbon fluid impermeability” and “useful in the manufacture of automotive hoses, belts, seals, dampers and engine mounts which require resistance to heat, pressure and hydrocarbon fluids” has not been given patentable weight. Case law holds that “where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation.” See *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997).

D’Amelia et al discloses a chewing gum composition comprising 1.5-25 wt % of certain vinyl polymers containing copolymers of vinyl alkyl esters (col. 4, line 30 to col. 5, line 28), copolymers of ethylene and vinyl alkyl esters (col. 5, line 30 to col. 6, line 36), and mixtures

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thereof (col. 7, lines 52-53); and up to 20 wt % fillers and plasticizers (see examples, e.g., Table 1).

In light of the above, it is clear that D'Amelia et al anticipates the presently cited claims.

12. Claims 1, 2, 6, 8, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Konno et al (US 2001/0006999).

Konno et al discloses a rubber composition suitable for a fuel system hose comprising 5-50 wt % of a vinyl chloride resin copolymerizable with at least one least monomer such as vinyl acetate and vinyl laurate (paragraphs 0019-0020); 90-55 wt % of an acrylonitrile-butadiene rubber (0011); and additives (paragraphs 0029-0032).

In light of the above, it is clear that Konno et al anticipates the presently cited claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenboom et al (US 6,464,607) in view of D'Amelia et al (US 4,968,511).

Rosenboom et al discloses a composition used in a power transmission belt comprising 0-50 parts by weight (pbw) of an elastomer such as ethylene-vinyl acetate copolymer (col. 3, lines 23-37); 0.5-3 phr fatty acids such as stearic acid; 5-250 phr of carbon black (col. 3, lines 58-67);



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0-80 phr silica (col. 4, lines 29-49); 1-100 phr plasticizer; 1-12 phr organic peroxides (col. 5, line 3-20); 1-30 phr of coagents such as triallyl cyanurate, triallyl phosphate, and n,n'-m-phenylene-dimaleimide (col. 5, lines 21-31); 1-5 phr antioxidant such as trimethyl-dihydroquinoline.

Rosenboom et al does not teach the use of a copolymer containing a first vinyl ester and second vinyl ester like presently claimed, however, note that Rosenboom et al is open to the use of any suitable reinforcing rubber, including ethylene-vinyl acetate copolymer (col. 3, lines 22-37).

D'Amelia et al discloses an elastomeric composition and teaches that any one of or a combination of (col. 7, lines 52-23) copolymers of two vinyl alkyl esters (e.g., vinyl acetate/vinyl laurate copolymer) (col. 4, line 30 to col. 5, line 29) and copolymers of ethylene and one vinyl alkyl ester (e.g., ethylene/vinyl acetate copolymer) (col. 5, line 30 to col. 6., line 36) may be used with no expectation of variation in the final product. Thus, it is the examiner's position that a copolymer of two vinyl alkyl esters and copolymer of ethylene and one vinyl alkyl ester are equivalent and interchangeable as taught by D'Amelia et al. Case law holds that the mere substitution of an equivalent (something equal in value or meaning, as taught by analogous prior art) is not an act of invention; where equivalency is known to the prior art, the substitution of one equivalent for another is not patentable. See *In re Ruff* 118 USPQ 343 (CCPA 1958).

Given that Rosenboom et al is open to the use of an suitable elastomeric rubber and given that a copolymer of two vinyl esters and a copolymer of ethylene and a vinyl ester are equivalent and interchangeable as taught by D'Amelia et al, it would have been obvious to one of ordinary skill in the art to utilize a copolymer of two vinyl alkyl esters (in particular, vinyl acetate/vinyl

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laurate) or a combination of the two copolymers in the composition of Rosenboom et al and thereby arrive at the presently cited claims.

While D'Amelia et al is drawn to a chewing gum formulation, the fact remains that it is also an elastomeric composition and therefore its teachings regarding vinyl ester copolymers is relevant and applicable.

14. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenboom et al (US 6,464,607) in view of D'Amelia et al (US 4,968,511) and further in view of Williams (US 5,492,971) and Barclay et al (US 2002/0042464).

The discussion with respect to Rosenboom et al and D'Amelia et al in paragraph 13 above is incorporated here by reference.

Rosenboom et al does not disclose the use of trioctyl trimellitates as a plasticizer or 1-octanedecanamine as a processing aid among its conventional additives, nevertheless, Rosenboom et al is open to the use of any conventional additive (col. 4, lines 19-28).

Williams discloses elastomeric compositions and describes a variety of conventional additives in elastomer compounding, including a processing aid such as octadecylamine (col. 4, lines 20-34).

Barclay et al discloses a cured elastomeric composition and teaches plasticizers such as trioctyl trimellitates commonly used in elastomeric systems (paragraph 0019).

Given that Rosenboom et al is open to the use of any conventional additive, it would have been obvious to one of ordinary skill in the art to utilize a commonly known processing aid such as octadecylamine as taught by Williams and a plasticizer such as trioctyl trimellitate as taught

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by Barclay et al in the composition of Rosenboom et al in suitable amounts and thereby arrive at the presently cited claims.

***Contact Information***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

6/23/2005

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